

United States
Circuit Court of Appeals *7*
For the Ninth Circuit.

LOUIS M. COLE,

Appellant,

vs.

ED. G. HOOKSTRATTEN CIGAR COMPANY (a
Corporation),

Appellee.

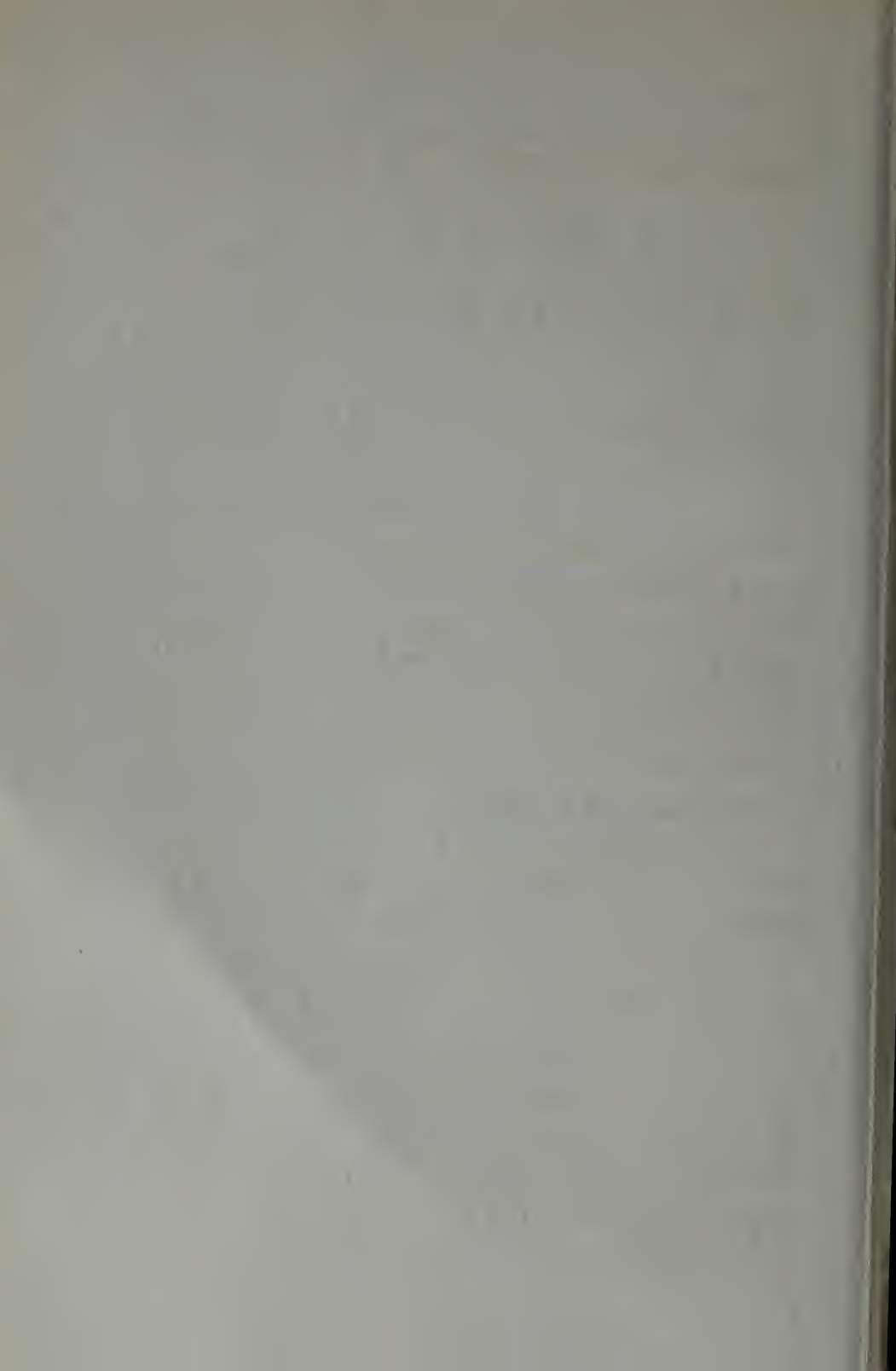
BRIEF FOR APPELLEE.

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F. D. MONCKTON,
CLERK.

JAMES R. OFFIELD,
Solicitor and of Counsel for Appellee.



*United States Circuit Court of Appeals for the
Ninth Circuit.*

No. 3050.

LOUIS M. COLE,

Appellant,

vs.

ED. G. HOOKSTRATTEN CIGAR COMPANY
(a Corporation),

Appellee.

Brief for Appellee.

The appellant in this cause is the alleged inventor of letters patent of the United States No. 1,054,826, dated March 4, 1913, and reissued October 26, 1915, No. 14,000. The appellant, in so far as the record shows, merely licenses or attempts to license the use of his invention to other manufacturers.

The appellee, Hookstratten Cigar Company, is a corporation operating a plurality of cigar-stores in the city of Los Angeles, and perhaps elsewhere, and among other things sells over its counters the chewing-gum product of Wm. Wrigley Jr. Co., of Chicago, Illinois, the manufacturers of Spearmint gum.

It is contended by the appellant that the label used by Wm. Wrigley Jr. Co. upon its Spearmint chewing-gum is an infringement of the reissue letters patent, and that the Hookstratten Cigar Company is an infringer by reason of its sale of the alleged infringing label.

The cause was tried in open court in the United States District Court of California, Southern Division, before his Honor, Judge Bledsoe, a copy of the opinion being found upon page 19 of the record.

The evidence was all stipulated and the defenses raised were (1st) want of patentable novelty and invention, and (2d) noninfringement.

His Honor, Judge Bledsoe, held that there was no infringement of any claim of the reissue patent, whereupon the cause comes before your Honors for a final consideration of the matter.

THE CLAIMS OF THE REISSUE PATENT.

The first claim of the patent specifies that the label is "to be detachably fastened around a can, provided on its upper and lower edges with retaining flanges." This claim is manifestly not infringed by reason of the fact that the appellee's structure in no way embodies a can, and the remaining portion of the claim need not be therefore considered.

Claim 2 provides "a label adapted to be detachably secured around a container," and in the sense as used in the specification of the patent and as disclosed in the drawing, the chewing-gum product of Wm. Wrigley Jr. Company is not sold in any container. The carton in which twenty five-cent packages of chewing-gum are contained is known to the trade as a container, whereas a label or wrapper for holding five individual sticks of chewing-gum together cannot be rightfully said to be a container, and therefore it is thought that claim 2 cannot be urged to include the label in question.

Claim 3, however, specifies "a label adapted to be detachably secured around a package," and it is upon this claim that the appellant largely predicates his case. An examination of the Wrigley package shows (1st) that it has a label adapted to be detachably secured around a package; (2d) that said label has display matter relating to the contents of the package on its outer face; (3d) that the inner face of the label bears useful printed matter; and it remains for the decision of this court, if claim 3 is valid, to determine whether the Wrigley label has an element in its composition which meets the following described element of claim 3, to wit:

"Said label being provided on the outer face thereof with a line out of registry with said useful printed matter indicating where the label may be severed to remove the entire label without mutilating the printed matter on its inner face."

THE FILE HISTORIES OF THE ORIGINAL AND REISSUE PATENTS.

The file history of the original patent is printed, beginning upon page 33 of the record. The first four claims embodied in the application were all rejected by the Examiner on certain prior patents, whereupon three new claims were submitted and all again rejected as involving no invention over the prior art.

Two new claims were thereupon submitted which were rejected, resubmitted and again rejected as involving no invention, and finally a single claim

was submitted which after amendment was agreed upon by the Examiner and the solicitors to contain patentable novelty and therefore allowed. This claim appears in the original patent found following page 44 of the record and is only of consequence in that it could in no wise be said that the label of Wm. Wrigley Jr. Company was an infringement of this claim. The original patent was thereupon surrendered and a reissue application filed December 26, 1914.

This reissue application contained three new claims, claim 1 of which was limited to the application of a label to a can having retaining flanges, and allowed, whereas claims 2 and 3 were rejected on certain prior art patents. Thereupon amendment was made to all of the claims and in the next action claim 1 was allowed and claims 2 and 3 again rejected.

It is to be noted at this point that the amendment to these claims, found upon page 52 of the record, pertain to the location and character of the printed line on the label.

The Examiner thereupon stated as follows:

“On review, the claims are rejected as covering unpatentable combinations.”

New claims were thereupon submitted and after further argument and amendment the claims were allowed as now appearing in the reissue patent.

The references cited by the Examiner are found in the record immediately following page 58, and an examination of these prior art patents, in view

of the file history of the patent, must necessarily restrict and confine the invention of the Cole patent, if there is any invention, to its most minute and last detail.

WHAT IS THE INVENTION OF THE COLE REISSUE PATENT IN SO FAR AS CLAIMS 2 OR 3 ARE CONCERNED?

There was no invention, of course, in detachably securing a label to a package as this is clearly shown in the prior art patents found in this record, nor was there any novelty in placing display matter relating to the contents of the package on the outer face of the label, as this was old and well-known practice. Furthermore, it was old in the art to print on the inner face of the label certain text or subject matter either in the form of directions or coupons, and lastly, it was old in the art to indicate or provide means on the label for severing it or a portion of it in order to save the label in its entirety or a part thereof, such as disclosed in patents No. 418,122 of December 24, 1889; No. 1,004,055 of September 26, 1911; No. 814,592 of March 6, 1906, as well as various other patents in the art, so that the question of novelty and invention would appear to center upon the word "severed" as found in both claims 2 and 3.

Now, "severing" does not mean "detaching," for in the prior patent No. 566,761 of September 1, 1896, there is a label shown which is adapted to be separated or detached from the container there shown, and it was in view of such patents as Martin, Braly, Schwab and Hosmer that the inventor was compelled

to abandon in his claims such a broad phrase as "means indicating where the wrapper may be *detached* from the package," and confine himself to the narrow restricted and specific limitation as found in the claims, namely, a complete severance or a physical cutting of the label at a designated point.

It, therefore, being old to print a coupon, directions, offers, or premium lists on the rear side of labels containing advertising matter on the front side, is there any invention in providing a label so marked or printed with a line on the outside indicating where the label may be severed for the purpose of saving the coupon on the reverse side?

Another salient limitation in both claims 2 and 3 is in claim 2 "a line disposed transversely thereto and out of registry with said useful printed matter," and in claim 3, "a line out of registry with said useful printed matter." The Court's attention is called to this limitation because there is a specific line in the Cole patent extending entirely across the label and indicating the precise point where the label must be severed, whereas in the appellee's label there is no line indicating where the label should be severed for the very good reason that a cutting or severance of the label as contemplated by the Cole patent is not intended in the appellee's label.

THE APPELLEE DOES NOT INFRINGE.

The packages of Spearmint chewing-gum introduced in evidence in this cause are all machine-wrapped, and this has been the practice among chewing-gum manufacturers for many years. The wrapping machines, after wrapping the individual

sticks of gum mechanically place five sticks in a bundle and apply a wax wrapper to the five sticks. What is known to the trade as a label or counterband is next applied to the five sticks of gum and a small quantity of glue or other adhesive material is applied to the outside of the label near one edge, so that when the other end of the label overlies the end upon which the adhesive material is deposited, the two ends of the label are thus gently secured together, leaving one edge of the label free whereby the label may be easily removed either for the purpose of saving the label or for facilitating its removal by the purchaser. For many years it has been the practice of Wm. Wrigley Jr. Company and its predecessors, Zeno Manufacturing Company, to lightly secure the ends of its labels or counterbands together for facilitating their removal. Evidence to this effect was stipulated, as appears upon page 25 of the record.

The separating of the two ends of the label is in no sense a severance of the label within the intent or spirit of the Cole patent. The removal of the Wrigley label is much the same as where two ends of a string are tied together and are separated by untying the knot. In no way could the untying of the knot be considered as a "severance" of the string. To sever implies a division, and a division means a separation into two or more parts. In the Cole patent the label is separated into two or more parts because when the label is cut along the line as indicated, what was before severance was one end of the label is now secured to the other end of the label, hence

the original label is separated into two parts; but in the Wrigley label there is no separation or division into two parts as the label, when its ends are separated, is still the same unit as it was when originally applied. For these very obvious and simple reasons it is submitted that the label of the appellee is in no wise severed, and hence there is no infringement of either claims 2 or 3 of the Cole patent.

Again, the Wrigley label is not provided with any specific line as called for in claims 2 and 3 indicating where it is to be severed. Counsel for appellant, on page 8 of his brief, is a little dubious as to where this line is on appellee's label, stating that it is either "the line formed by the free edge of defendant's label," or "the waved line" beneath the words "Remove Carefully," or "the straight line above said words." There is in this statement of counsel a clear intention of having claims 2 and 3 broadened beyond the scope of even the reissue patent which amounts practically to a reissue of the reissue. Bear in mind that the patentee attempted to obtain a claim of substantially the same scope which counsel is now attempting to have this Court place upon the claims in question, and that such a claim was flatly denied by the Patent Office in its rejection of January 2, 1915, found on page 49 of the record.

As appellee's label is not intended to be severed it necessarily follows that there is no reason for having a line indicating where it might be severed, and inasmuch as the line is absent and there is no proof that severance of the label is contemplated, it is submitted that there can be no infringement

of claims 2 and 3 where the only element of these claims which could possibly give life or patentable novelty to them is absent from appellee's structure.

CLAIMS 2 AND 3 INVALID FOR WANT OF PATENTABLE NOVELTY AND INVENTION.

It is thought that claims 2 and 3 of the patent are without any semblance of patentable novelty or invention in view of certain stipulated prior uses appearing in this record. Colgate & Company's label, Exhibit "L," contains every element of claims 2 and 3, assuming that a cake of soap is a "container" as defined in claim 2, or a "package" as defined in claim 3. This label is unquestionably intended to be detachably secured around a cake of soap. It has printed matter on one side, a coupon on the reverse side, and a prominent notice on the face of the label to cut the same along certain well defined lines in order to save the coupon on the reverse side. Babbitt's soap label, Exhibit "N," is of the same character, and this is true of the Procter & Gamble soap labels, Exhibits "O," "P" and "Q." From the soap label exhibits in this case it appears to have been common practice to have a coupon on the rear side of a label and with a notice on the front side where to cut the label so as not to destroy the coupon.

The best example, perhaps, of a prior use is in Defendant's Exhibit "K," Borden's Condensed Milk Co. label. This label is divided into three sections by gold division lines, the center section having a list of premium stores on the back side of the label

which is certainly "useful printed matter" within the meaning of the claims, and upon the left hand panel of the label is this notice: "Save Center Panel of this Label," entire front reading: "STAR BRAND CONDENSED MILK." The gold lines on either side of the word "Star" clearly indicate that portion of the label which should not be mutilated in case the label is removed, and it is thought that this label meets every element of both claims 2 and 3.

Unquestionably this label would be an infringement of claims 2 and 3 if not an anticipation, and applying the well-known rule that if a structure anticipates it will necessarily infringe a claim, it would seem certain that Exhibit "K" fully and clearly meets every element of claims 2 and 3, and hence these claims are invalid for want of patentable novelty and invention by reason of this admitted prior use.

THE LAW AS APPLICABLE TO THE FACTS IN THIS CASE.

It is difficult to see what the patentee Cole did in view of the prior art as disclosed in the history of the patent and the admitted prior uses of record. Under the heading of "Invention" in appellant's brief, it was thought that some light might be thrown on the question of where the invention resided in claims 2 and 3, but the discussion and references apply to other cases considered by the courts and in no wise appear to be applicable to this one. From the most advantageous viewpoint that counsel for appellee is able to analyze the invention, all that Cole did

was to bring certain extremely old and well-known elements together and not even produced a new combination or new results. The established rule of law was long ago laid down in *Hailes v. Van Wormer*, 20 Wall. 353:

“Merely bringing old devices into juxtaposition and there allowing each to work out its own effect without the production of something novel is not invention.”

In *Office Specialty Manufacturing Co. v. Fenton Metallic Manufacturing Co.*, 174 U. S., 492, the facts were much similar to the facts in the present case, because the Hoffman patent was merely an aggregation of prior well-known devices, and the Court so confined the claim that no infringement was found. In that case the Court said:

“Putting the Hoffman patent in its most favorable light, it is very little, if anything, more than an aggregation of prior well-known devices, each constituent of which aggregation performs its own appropriate function in the old way. Where a combination of old devices produces a new result such combination is doubtless patentable, but where the combination is not only of old elements, but of old results, and no new function is evolved from such combination, it falls within the rulings of this court in *Hailes v. Van Wormer*, 20 Wall. 353, 368; *Reckendorfer v. Faber*, 92 U. S. 347, 356; *Phillips v. Detroit*, 111 U. S. 604; *Brinkerhoff v. Aloe*, 146 U. S. 515, 517; *Palmer v. Corning*, 156 U. S.

342, 345; Richards v. Chase Elevator Co., 158 U. S. 299. Hoffman may have succeeded in producing a shelf more convenient and more salable than any which preceded it, but he has done it principally, if any wholly, by the exercise of mechanical skill.

CONCLUSIONS.

It is therefore respectfully submitted that claims 2 and 3 of the Cole patent are not infringed—

(1st) Because the appellee's construction has no line "out of registry with said useful printed matter indicating where said label should be severed," as specified in claims 2 and 3, and

(2d) Assuming that there is such a line on appellee's label, the said label is not designed nor is the same intended to be severed in the sense of the Cole patent, hence there is no infringement.

(3d) It is furthermore respectfully submitted that Exhibit "K" meets every element of claims 2 and 3 of the patent in suit, and hence these claims are invalid for want of patentable novelty and invention in view of this stipulated instance of prior use.

Respectfully submitted,
JAMES R. OFFIELD,
Solicitor and of Counsel for Appellee.